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In re Application of
David A. Connolly et al
Application No. 08/926,187
Filed: September 9, 1997

: DECISION OFFICE OF PETITIONS
: ON
: PETITION
:

This is a decision on the combined petition filed on May 23, 2009 ("the May 23, 2009 combined petition"), which includes:

- a petition under 37 CFR 1.137(a) to revive an unavoidably abandoned application, and
- an alternative petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application.

This decision also addresses the paper filed on April 1, 2010 entitled "Supplement to Petition to Revive Abandoned Application" ("the April 1, 2010 supplement to the combined petition"), the completed form PTOL-85 entitled "Part B – Fee(s) Transmittal" filed on April 1, 2010 ("the April 1, 2010 issue fee payment"), as well as the statement under 3.73(b) filed on May 23, 2009, and power of attorney and change of correspondence address, also filed on May 23, 2009.

The combined petition filed on May 23, 2009, the April 1, 2010 supplement to the combined petition, the April 1, 2010 issue fee payment, the May 23, 2009 statement under 3.73(b), the May 23, 2009 power of attorney and change of correspondence address, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The $540 petition fee set forth in 37 CFR 1.17(l) for the present petition under 37 CFR 1.137(a), and the petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b), will be charged to deposit account no. 50-2469 as authorized on the May 23, 2009 fees transmittal form, on page 8 of the May 23, 2009 combined petition, and on page 4 of the April 1, 2010 supplement to the combined petition. The $1510 issue fee and the $300 publication fee will also be charged to deposit account no. 50-2469, as authorized by the completed form PTOL -85, entitled "Part B – Fee(s) Transmittal", filed on April 1, 2010.

SUMMARY

The petition under 37 CFR 1.137(a) to revive an unavoidably abandoned application, filed on May 23, 2009, is **dismissed**. The alternative petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application, filed on May 23, 2009, is **granted**. The May 23, 2009 statement under 3.73(b), and the May 23, 2009 power of attorney and change of correspondence address, are **effective**.

DECISION

The Petition under 37 CFR 1.137(a) to Revive an Unavoidably Abandoned Application

On July 15, 1999, a notice of allowance and issue fee due was mailed by the Office, setting a three-month statutory period for reply. On May 24, 2000, a notice of abandonment was mailed by the Office, stating that the application was abandoned in view of "[a]pplicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance". The present application was abandoned as of October 16, 1999. The present petition under 37 CFR 1.137(a), however, was not filed until May 23, 2009, nearly ten years later.

In evaluating a petition under 37 CFR 1.137, three periods are considered:[1]

(1) the delay in the reply that originally resulted in the abandonment,
(2) the delay in filing an initial petition under 37 CFR 1.137 to revive the application, and
(3) the delay in filing a *grantable* petition under 37 CFR 1.137 to revive the application.

Regarding period (1), the applicant has provided evidence to show that the delay in the reply that originally resulted in the abandonment of the application may have been unavoidable. Period (3) is not applicable, because the present petition is the initial petition filed under 37 CFR 1.137.[2] Regarding period (2), however, the present petition lacks sufficient evidence to show that the delay in filing the initial petition under 37 CFR 1.137(a) was unavoidable.

The applicant states that the applicant "was aware that the application was abandoned on or about September 16, 2008."[3] However, the applicant has not provided any evidence that the applicant was first notified of the abandonment of the application on this date.[4] Even assuming that the applicant was first notified of the abandonment of the application on September 16, 2008, however, the present petition under 37 CFR 1.137(a) was not filed by the applicant until May 23, 2009, more than eight months later.

MPEP 711.03(C), subsection II D, provides, in pertinent part:

> Where a petition pursuant to 37 CFR 1.137(a) . . . is not filed within 3 months of the date the applicant is first notified that the application is abandoned . . . the Office will require a showing as to how the delay between the date the applicant was first notified that the application was abandoned and the date a 37 CFR 1.137(a) petition was filed was "unavoidable".

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[1] See MPEP 711.03(c), subsection II D.

[2] For example, if a timely filed petition under 37 CFR 1.137 were dismissed on other grounds, applicant cannot intentionally delay the filing of a renewed petition Applicant must provide a showing that any delay in a renewed, and grantable, petition is either unavoidable (for petitions under 37 CFR 1.137(a)) or unintentional (for petitions under 37 CFR 1.137(b)). See *In re Application of Takao*, 1990 Comm'r Pat. LEXIS 6, 17 USPQ2d 1155 (Comm'r Pat. 1990).

[3] See page 2 of the April 1, 2010 supplement to the combined petition.

[4] While the applicant refers to a September 16, 2008 letter from the law firm of Brinks, Hofer, Gilson, and Lione ("Brinks Hofer"), applicant's former counsel, to the in-house attorney for the applicant, a copy of the letter has not been provided with the present petition.

The applicant has presented evidence that Mr. Prendergast, a former attorney of record, may have intentionally concealed the abandonment of this application from his law firm, Brinks Hofer Gilson and Lione ("Brinks Hofer") and from the applicant. The applicant also states that the delay in filing the present petition was due to the time required for Brinks Hofer to complete their internal investigation and provide the results to the applicant, the time required to determine which documents available in the records were falsified and which documents "were true", and the time required for applicant's current representative to review the file and the results of the investigation by Brinks Hofer.[5]

The evidence and statements presented by the applicant may show how the eight-month delay between September 16, 2008, the date that applicant states that he was aware of the abandonment,[6] and May 23, 2009, the filing date of the present petition, was unintentional. However, the applicant has not clearly shown how the *entire* eight-month delay was *unavoidable*. For example, the applicant has not provided evidence of when the applicant was first notified of the abandonment of the application. As another example, the applicant has not provided evidence showing the stage of the investigation on December 16, 2008, i.e., what had been accomplished as of December 16, 2008, three months after the applicant may have been first notified of the abandonment, and why a delay of an additional five months in order to file the present petition was unavoidable.

In addition, a grantable petition under 37 CFR 1.137(a) must be accompanied by (1) a reply to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(l), (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable,[7] and (4) any terminal disclaimer (and fee) required by 37 CFR 1.137(d).

The applicant has submitted, with the present petition filed on May 23, 2009, a payment of the issue fee and publication fee,[8] and a petition fee under 37 CFR 37 CFR 1.17(l), which satisfy items (1) and (2), respectively. Regarding item (4), no terminal disclaimer is required pursuant to 37 CFR 1.137(d), because the present application was filed after June 5, 1995. The applicant has not, however, satisfied item (3), because the applicant has not shown that the *entire* delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable.

Furthermore, where, as here, a petition under 37 CFR 1.137(a) is filed more than one year after the date of the abandonment of the application,[9] the applicant must also provide (see MPEP 711.03(c), subsection II D):

A. further information as to when the applicant (or applicant's representative) first became aware of the abandonment of the application; and

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[5] See page 3 of the April 1, 2010 supplement to the combined petition.
[6] Assuming, again, that the applicant was first notified of the abandonment of the application on that date.
[7] See 35 U.S.C. 133.
[8] See MPEP 711.03(c), subsection II A 1 and the April 1, 2010 issue fee payment.
[9] March 22, 2007.

B. a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant (or applicant's representative).

As stated above, the applicant has provided further information as to when the applicant became aware of the abandonment of the application, but has not provided information as to when the applicant *first* became aware of the abandonment of the application. In addition, the applicant has not provided a sufficient showing as to how the *entire* delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In determining if the delay was unavoidable, courts have adopted the standard of due care of a reasonably prudent person:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. *In re Mattullath* , 38 App. D.C. 497, 514-15 (1912), quoting and adopting *Ex Parte Pratt*, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).[10]

The applicant provides evidence that Mr. Prendergast may have intentionally misled the applicant regarding the status of the application, [11] and that Mr. Prendergast may have intentionally concealed the abandonment of this application from his law firm, Brinks Hofer.[12] The applicant has not, however, provided sufficient evidence that the *entire* delay in discovering the abandoned status of the application, from October 16, 1999, the date of the abandonment of the application, until the date that the applicant was first informed of the abandonment of the application by Brinks Hofer,[13] occurred despite *applicant's* diligence in prosecuting the application.[14]

The applicant has presented evidence showing that applicant instructed former counsel to pay the issue fee, and that former counsel apparently misled applicant into believing that the issue fee had been timely paid.[15] The applicant has also presented evidence that on or before January 25, 2003, more than four years after the due date for issue fee payment, which was the required reply to the outstanding Office action, applicant apparently communicated with Mr. Prendergast

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[10] See also *Ray v. Lehman*, 55 F.3d 606, 609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) ("Under . . . [35 U.S.C.] § 133, . . . the standard is unavoidable delay . . . in order to satisfy this standard, one must show that he exercised the due care of a reasonably prudent person").

[11] See, for example, "supplemental exhibit 1", which accompanied the April 1, 2010 supplement to the combined petition.

[12] See, for example, exhibit 9, the "Declaration of David S. Fleming in Support of Petition to Revive U.S. Patent Application No. 08/926,187", which accompanied the May 23, 2009 combined petition.

[13] As previously discussed, the applicant states that he was aware of the abandonment of the application on September 16, 2008, but has not provided evidence of when the applicant first became aware of the abandonment.

[14] Decisions on revival are made on a "case-by-case basis, taking of the all facts and circumstances into account". *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was unavoidable. See, e.g., *Haines v. Quigg*, 673 F. Supp. 314, 5 USPQ2d 1130 (N. D. Ind. 1987). See also MPEP 711.03(c), subsection II C 2.

[15] See exhibit 1 which accompanied the May 23, 2009 combined petition.

regarding the status of the present application.[16] The applicant states that the applicant "may have been aware that the application was abandoned on or before October 31, 2005".[17]

Evidence has not been presented, however, of when applicant first became aware of the abandonment of the application. Evidence has also not been presented of any inquiry by applicant regarding the status of the application, other than the above-discussed apparent inquiry on or before January 25, 2003, more than four years after the application became abandoned, and a possible second inquiry on or before October 31, 2005, more than six years after the application became abandoned.[18] In other words, the applicant has not presented evidence of any other inquiry, either by contacting applicant's former counsel, or by contacting the U.S. Patent and Trademark Office ("the Office"), during the *entire* time period between October 15, 1999, the due date for the reply to the outstanding Office action, and the date that applicant first learned of the abandonment, which, presumably, was September 16, 2008, nearly nine years after the due date for the reply.

For the reasons given above, the applicant has not submitted sufficient evidence showing:

1. the date that the applicant first became aware of the abandonment of the application,

2. how the delay between the date that the applicant first became aware of the abandonment of the application, and May 23, 2009, the filing date of present petition under 37 CFR 1.137(a), was unavoidable,

3. how the *entire* delay in discovering the abandonment of the application occurred despite the exercise, by the applicant, of due care and diligence in prosecuting the application, and

4. how the *entire* delay in filing the required reply from October 15, 1999, the due date for the reply, until the filing of a grantable petition was unavoidable, pursuant to 37 CFR 1.137(a)(3).[19]

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[16] See "supplemental exhibit 1" which accompanied the April 1, 2010 supplement to the combined petition.

[17] See page 2 of the April 1, 2010 supplement to the present petition. The applicant refers to an October 31, 2005 e-mail that was provided in exhibit 8, which accompanied the May 23, 2009 combined petition.

[18] The applicant presents evidence of an investigation into the status of this application from 2004 through early 2007 which was conducted by Brinks Hofer. See, particularly, paragraph no. 8 on page 2 of the declaration of David S. Fleming (exhibit 9 of the May 23, 2009 combined petition). This investigation presumably was initiated at some point by an inquiry from the applicant, but the applicant has not provided specific evidence of such an inquiry.

[19] The applicant cites *In re Lonardo*, 1990 Commr. Pat. LEXIS 18, 17 USPQ2d 1455 (Comm'r Pat. 1990), in which unavoidable delay was found where applicant's representative concealed the abandonment of the application from the applicant. In *Lonardo*, the diligence of both the applicant's representative, and of the applicant, was considered. "Proper considerations include the extent of diligence exhibited by the petitioner himself and by his attorney, in connection with the delay for which the application became abandoned and also with their respective efforts to revive the abandoned application." *Lonardo*, 17 USPQ2d at 1455. In *Lonardo*, however, the applicant provided evidence of when the applicant first learned of the abandoned status of the application, and also provided *specific* evidence of more than one inquiry by the applicant into the status of the application. See also *Huston v. Ladner*, 973 F.2d 1564, 23 USPQ2d 1910 (Fed. Cir. 1992), in which the court declined to hold that "attorney negligence" constituted good cause for excusing the failure to meet the Office requirement, expressly stating that the court was not bound by *Lonardo*.

Accordingly, the petition under 37 CFR 1.137(a), filed on May 23 2009, is **dismissed**.

The Petition under 37 CFR 1.137(b) to Revive an Unintentionally Abandoned Application

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a reply to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required reply from the due date of the reply to the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.[20] The applicant has filed a payment of the issue fee and publication fee,[21] and a petition fee under 37 CFR 1.17(m), which satisfy items (1) and (2), respectively.

The applicant also states that "the entire delay in paying the required issue fee form the due date for the issue fee until the filing of a grantable petition pursuant to 37 CFR §1.137(b) was unintentional",[22] which satisfies item (3).

This application has been abandoned for an extended period of time. In accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, the Office is relying on the duty of candor and good faith of the applicant and of applicant's representative. See also 37 CFR 1.4(d)(4), which incorporates 37 CFR 11.18(b), and *Changes to Patent Practice and Procedure,* 62 Fed. Reg. 53131, 53160, 53178; 1203 *Off. Gaz. Pat. Office* 63, 88, 103 (responses to comment nos. 64 and 109) (October 21, 1997) (final rule) (applicant's representative is obligated under [former] 37 CFR 10.18(b) [now 37 CFR 11.18(b)] to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b)(3) to the Office). The signatures appearing on the May 23, 2009 combined petition and on the April 1, 2010 supplement to the combined petition constitute a representation to the Office that the signing attorney has made an inquiry in accordance with 37 CFR 11.18(b), to ascertain that the delay was unintentional.

Accordingly, based on the certification under 37 CFR 1.4(d)(4), which incorporates 37 CFR 11.18(b), and on the specific facts and circumstances of this application, the petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application, filed on May 23, 2009, is **granted**.

The May 23, 2009 statement under 3.73(b), and the May 23, 2009 power of attorney and change of correspondence address, are **effective**.

CONCLUSION

- The petition under 37 CFR 1.137(a) to revive an unavoidably abandoned application, filed on May 23, 2009, is **dismissed**.

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[20]Regarding 37 CFR 1.137(b)(4), no terminal disclaimer is required pursuant to 37 CFR 1.137(d), because the present application was filed after June 5, 1995.

[21] See MPEP 711.03(c), subsection II A 1 and the April 1, 2010 issue fee payment.

[22] See page 7 of the May 23, 2009 combined petition.

- The alternative petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application, filed on May 23, 2009, is **granted**.

- The May 23, 2009 statement under 3.73(b), and the May 23, 2009 power of attorney and change of correspondence address, are **effective**.

- This application is being forwarded to the Office of Publications for processing of the issue fee and publication fee filed on April 1, 2010.

- Any inquiry concerning this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724.

Brian E. Hanlon
Director
Office of Patent Legal Administration